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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,320	07/05/2001	Dale Francis Obeshaw	DP-301289	2127

7590 01/13/2004

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EXAMINER

MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 01/13/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-14

Office Action Summary	Application No.	Applicant(s)	
	09/899,320	OBESHAW	
	Examiner	Art Unit	
	Michael C. Miggins	1772	

-- Th MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 21-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-20 and 36-39 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the methods proposed by the office would not make the claimed product. This is not found persuasive because applicant has not pointed out why the proposed methods would not make applicant's claimed invention.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 21-35 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

REJECTIONS WITHDRAWN

3. There are no rejections withdrawn.

REJECTIONS REPEATED

4. The 35 USC 102(b) rejection of claims 36-39 as being anticipated by Martin are repeated for the reasons previously of record in paper #10, pages 3-4, paragraphs 9-10. Applicant has added the limitation "... honeycomb core ..." to claims 36-38 which as stated previously in the 102(b) rejection of claims 36-39 set forth in paper #10, pages 3-4, paragraphs 9-10 is part of a method limitation in a product claim and has therefore been given little to no patentable weight. All of the 35 USC 103(a) rejections are

repeated for the reasons previously of record in paper #10, pages 4-9, paragraphs 11-14.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments with regard to claims 1-20 and 36-39 have been carefully considered but are deemed unpersuasive.

Applicant has argued that the 102(b) rejection of claims 36-39 as being anticipated by Martin is improper. Claims 36-39 are product-by-process claims which consist essentially of method limitations, the limitation "... A contoured structural member ..." is the only product limitation in claims 36-39. Martin does not have to teach any of the method limitations to read on applicant's claims. Furthermore, Martin teaches a contoured structural member (column 5, lines 56-61).

Applicant has argued that the 103(a) rejection over Martin in view of Crane is improper. Applicant has argued that Martin does not teach that the inner and outer layers are made of a composite material and instead only refers to metal alloys. However, Martin specifically states "... The metals utilized for the shell containers and core materials employed in the techniques illustrated in Figs. 2 and 3 may comprise any metal, metal alloy or composite ..." (see column 5, lines 21-26). Applicant's argument that the skilled artisan would have understood that the word "composite" is not used in the sense of a material, i.e., a composite material but instead means a metal mixture or mixture of metals. However, Martin specifically teaches that the material can be any metal, metal alloy or composite (see column 5, lines 21-26) and it is unlikely that Martin

would describe the material as a metal alloy and in the very next word describe the material as a composite if the words "metal alloy" and "composite" are to be construed as equivalent.

Applicant has argued that the combination of Martin in view of Crane is improper since Martin does not teach a composite material and Crane teaches the use of composite materials. However, Martin teaches the use of composite materials as described above. Furthermore, the teachings of Crane were relied upon in the proposed combination for the teaching of inner and outer layers comprising a plurality of layers. The proposed combination did not intend to replace the materials of Martin with the materials of Crane. The proposed combination only intends to use a plurality of layers in the inner and outer layers for the purpose of providing improved damping characteristics in terms of dissipation of mechanical and acoustic-energy as well as improved structural characteristics in terms of damage tolerance.

In response to applicant's argument that the combination of Martin and Crane is improper, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is that the plurality of layers used in the inner and outer layers of Crane provides improved damping characteristics in terms of dissipation of mechanical and acoustic-energy as well as improved structural characteristics in terms of damage tolerance.

Applicant has argued that Martin does not describe an enabling disclosure for a non-sandwich type structure. However, Martin specifically states "... The shell geometry should also be amenable to producing a consolidated billet that can undergo subsequent deformation processing to form any desired structural elements, e.g., cylinders or rectangular plates ..." (column 5, lines 56-61). Applicant refers to MPEP 2121.04; however, MPEP 2121.04 describes an enabling disclosure with regards to drawings. Martin specifically teaches a cylindrical structure in the text of the disclosure and thus Martin is clearly enabling for a cylindrical structure. Furthermore, Martin does not have describe specifically how such a cylindrical structure is formed to be enabled since Martin specifically teaches a cylindrical structure.

Applicant has argued that the rest of the 103(a) rejections set forth in paper #10 are improper for the same reasons as that of the Martin in view of Crane combination and that the Casser and Reid et al. references do not provide the alleged deficiencies of

the Martin in view of Crane combination. All of applicant's arguments with regard to the Martin in view of Crane combination have been addressed above and thus the Casser and Reid et al. references are not required to provide the alleged deficiencies of Martin and Crane.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1772

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MCM *mc*
January 5, 2004

[Signature]
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1/7/2 *1/8/04*